

REMARKS

Claims 1-8 are all the claims pending in the application.

Reconsideration and review of the rejections is respectfully requested.

Claim Rejections – 35 U.S.C. §§102 and 103

Claims 1-8 have been rejected under 35 U.S.C. § 102(a) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over WO 01/29129 to Statz (Statz '129). The Examiner states that the reference neutralizes blends of stearic acid and ethylene/acrylate/acid terpolymer (see Table 2), and that the material is useful in golf ball production (see abstract).

Applicants respond as follows.

In response, and without admitting that this rejection is correct, enclosed herewith is a verified translation of the Japanese priority application.

Accordingly, Applicants respectfully request that the rejection based upon Statz '129 be withdrawn.

Claims 1-8 have been rejected under 35 U.S.C. § 102(a/e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Publication No. 2001/0018375 to Hayashi. The Examiner states that the reference neutralizes blends of behenic acid and ethylene/acrylate/acid ionomer (see Table 2), and that the material is useful in golf ball production.

Applicants respond as follows.

In response, and without admitting that this rejection is correct, enclosed herewith is a verified translation of the Japanese priority application.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 1-8 have been rejected under 35 U.S.C. § 102(a/e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Nos. 2002/0061793 or 2002/0055400 both to Higuchi. The Examiner states that both of these references exemplify neutralizing blends of fatty acid with ethylene/acrylate/acid ionomer and that the material is useful in golf balls.

Applicants respond as follows.

First, Applicants submit that neither the '400 nor the '793 Publications qualify as prior art under 35 U.S.C. § 102(a). Neither application was published prior to the filing date of the instant application. The '400 document published May 9, 2002, and the '793 document published May 23, 2002. The present application was filed on November 18, 2001. Accordingly, withdrawal of this portion of the rejection is requested.

With regard to the portion of the rejection based upon 35 U.S.C. § 102(e), Applicants submit herewith Declarations from the inventors of the present Application and the '400 and '793 Publications demonstrating that the relevant disclosure in those publications is not prior art. Accordingly, withdrawal of this portion of the rejection is requested.

With regard to the portion of the rejection based upon 35 U.S.C. § 103, Applicants submit that in view of the common ownership of the present application and the '400 and '793

documents, as evidenced by the attached copies of the recorded assignments, this rejection should be withdrawn. 35 U.S.C. § 103(c).

Accordingly, Applicants respectfully request that these rejections be withdrawn.

Claims 1-8 have been rejected under 35 U.S.C. § 102(a) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over WO 00/23519 to Statz. Statz '519 is relied upon to exemplify (see table 7) blends of ethylene/acrylate/acid terpolymer, stearic acid and magnesium hydroxide. Alternatively, the terpolymer can assertedly be a partially neutralized ionomer (page 10, line 11).

Applicants respond as follows.

Applicants amend Claim 1 to recite a base resin *consisting of* (a) an olefin-unsaturated carboxylic acid binary random copolymer or a metal ion-neutralized olefin-unsaturated carboxylic acid binary random copolymer or both, blended with (b) an olefin-unsaturated carboxylic acid-unsaturated carboxylate ternary random copolymer or a metal ion-neutralized olefin-unsaturated carboxylic acid-unsaturated carboxylate ternary random copolymer or both, in a weight ratio of 0:100 to 30:70.

On the other hand, the composition disclosed by Statz '519 includes a thermoplastic elastomer (component (a)) as an essential component. The thermoplastic elastomer of Statz is selected from copolyetheramides, copolyetheresters, elastomeric polyolefins, block polystyrene polydiene copolymers, and thermoplastic polyurethanes. As noted above, Statz is relied upon as exemplifying blends of ethylene/acrylate/acid terpolymer, stearic acid and magnesium hydroxide (see Table 7). However, it should be noted that Examples No. 17a, 17b, 17c, 18a and 18b are

examples of ionomer components, which are not immediately used as a golf ball material until these ionomers are blended with thermoplastic polyester elastomer (trade mark: Hytrel) in the specific proportion to be used as the base material of the cores (see Table 8). That is, the golf ball material described by the examples of Statz '519 include thermoplastic polyester elastomer as an essential component.

Accordingly, Statz '519 fails to disclose or suggest the claimed base resin as recited in Claim 1.

Double Patenting Rejections

Claims 1-8 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims over copending U.S. Application Nos. 09/778,828, 09/906,844, 09/906,638 and 09/695,140.

Applicants respond as follows.

Applicants concurrently herewith file a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome these rejections.

In view of the above, Applicants respectfully request withdrawal of the provisional double patenting rejections of Claims 1-8.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No. 09/994,729

Attorney Docket: Q67465

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



John T. Callahan
Registration No. 32,607

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: August 6, 2003



PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Rinya TAKESUE, et al.

Appln. No.: 09/994,729

Group Art Unit: 1714

Filed: November 28, 2001

Examiner: David BUTTNER

For: GOLF BALL MATERIAL AND GOLF BALL

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
Washington, D.C. 20231

Sir:

We, Rinya Takesue and Yasushi Ichikawa, do hereby declare and state that:

We are the named co-inventors of the invention described and claimed in the above-identified application and we are familiar with the prosecution of this application, including the Office Action dated February 7, 2003, wherein the Examiner rejected the above-identified application, as allegedly anticipated by or, in the alternative, as obvious over Higuchi, *et al.* (U.S. Patent Application Publication US 2002/0055400) ("Higuchi '400") or Higuchi, *et al.* (U.S. Patent Application Publication US 2002/0061793) ("Higuchi '793"). We are also two of the four inventors of each of Higuchi '400 and Higuchi '793.

We further declare and state that we invented the relevant subject matter disclosed in the Higuchi '793 reference which was relied upon in the rejection under 35 U.S.C. § 102(e) over Higuchi '793 contained in the Office Action dated February 7, 2003, which includes:

The resin composition disclosed in paragraphs [0009] to [0016] including: 100 parts by weight of an olefin-unsaturated carboxylic acid random copolymer, an olefin-unsaturated carboxylic acid-unsaturated carboxylate random copolymer, a metal ion neutralized product of each of the copolymers, or a mixture of each of the copolymer and the neutralized product; 5 to 80 parts by weight of a fatty acid having a molecular weight of at least 280 or derivative thereof; and 0.1 to 10 parts by weight of a basic inorganic metal compound capable of neutralizing acid groups in the two foregoing components.

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We also necessarily invented the Shore D hardness and melt index of that resin composition. *See, paragraphs [0015] and [0017].* We also invented the zinc ion-neutralized ionomer resin described in paragraph [0052]. The disclosure of the acid group neutralization (at least 50 mol %), is also our invention (*see, paragraph [0022]*), as are the examples of suitable fatty acids in paragraph [0057] including stearic acid, behenic acid, arachidic acid and lignoceric acid. The basic inorganic metal compound disclosed in paragraph [0065] including calcium hydroxide is also our invention, as was generally the use of the foregoing materials in a golf ball. Our contribution to Higuchi '793 did not include aspects of the golf ball disclosure.

We also declare and state that we invented the relevant subject matter disclosed in Higuchi '400 which was relied upon in the rejection under 35 U.S.C. § 102(e) over Higuchi '400 contained in the Office Action dated February 7, 2003), which includes:

the resin composition disclosed in paragraphs [0012] to [0014] including: 100 parts by weight of an olefin-unsaturated carboxylic acid random copolymer, an olefin-unsaturated carboxylic acid-unsaturated carboxylate random copolymer, a metal ion neutralized product of each of the copolymers, or a mixture of each copolymer and the neutralized product; 5 to 80 parts by weight of a fatty acid having a molecular weight of at least 280 or derivative thereof; and 0.1 to 10 parts by weight of a basic inorganic metal compound capable of neutralizing acid groups in the two foregoing components.

We also necessarily invented the Shore D hardness and melt index of that resin composition. *See, paragraphs [0015] and [0017].* We also invented the zinc-ion neutralized ionomer resin described in paragraph [0052]. The disclosure of the acid group neutralization (at least 50 mole %), is also our invention (*see, paragraph [0022]*), as are the examples of suitable fatty acids in paragraph [0056] including stearic acid, behenic acid, arachidic acid and lignoceric acid. The basic inorganic metal compound disclosed in paragraph [0064] including calcium hydroxide is also our invention, as was generally the use of the foregoing materials in a golf ball. Our contribution to the Higuchi '400 Patent did not include aspects of the golf ball.

We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these

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statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: Jul. 23, 2003

Rinya Takasue
Rinya Takasue

Date: Jul. 24, 2003

Yasushi Ichikawa
Yasushi Ichikawa



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Rinya TAKESUE, et al.

Appn. No.: 09/994,729

Group Art Unit: 1714

Filed: November 28, 2001

Examiner: David BUTTNER

For: **GOLF BALL MATERIAL AND GOLF BALL**

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
Washington, D.C. 20231

Sir:

We, Hiroshi Higuchi and Hirotaka Shimosaka, do hereby declare and state that:

We are the named co-inventors, along with Rinya Takesue and Yasushi Ichikawa, in Higuchi, *et al.* (U.S. Patent Application Publication US 2002/0055400) ("Higuchi '400") and Higuchi, *et al.* (U.S. Patent Application Publication US 2002/0061793) ("Higuchi '793").

We further declare and state that we are familiar with the prosecution of the above-identified application, including the Office Action dated February 7, 2003, wherein the Examiner rejected the above-identified application, as allegedly anticipated by or, in the alternative, as obvious over Higuchi '400 and Higuchi '793.

We declare and state that we did not invent the subject matter disclosed in Higuchi '793 which was relied upon in the rejection under 35 U.S.C. § 102(e) over Higuchi '793 contained in the Office Action dated February 7, 2003, which includes:

The resin composition disclosed in paragraphs [0009] to [0016] including: 100 parts by weight of an olefin-unsaturated carboxylic acid random copolymer, an olefin-unsaturated carboxylic acid-unsaturated carboxylate random copolymer, a metal ion neutralized product of each of the copolymers, or a mixture of each of the copolymer and the neutralized product; 5 to 80 parts by weight of a fatty acid having a molecular weight of at least 280 or derivative thereof; and 0.1 to 10 parts by weight of a basic inorganic metal compound capable of neutralizing acid groups in the two foregoing components.

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We also necessarily did not invent the Shore D hardness and melt index of that resin composition. *See*, paragraphs [0015] and [0017]. We also did not invent the zinc ion-neutralized ionomer resin described in paragraph [0052]. The disclosure of the acid group neutralization (at least 50 mol %), is also not our invention (*see*, paragraph [0022], as are also not the examples of fatty acids in paragraph [0057] including stearic acid, behenic acid, arachidic acid and lignoceric acid. The basic inorganic metal compound disclosed in paragraph [0065] including calcium hydroxide is also not our invention. Our contribution to Higuchi '793 was certain aspects of the golf ball.

We also declare and state that we did not invent the relevant subject matter disclosed in Higuchi '400 which was relied upon in the rejection under 35 U.S.C. § 102(e) over Higuchi '400 contained in the Office Action dated February 7, 2003), which includes:

the resin composition disclosed in paragraphs [0012] to [0014] including: 100 parts by weight of an olefin-unsaturated carboxylic acid random copolymer, an olefin-unsaturated carboxylic acid-unsaturated carboxylate random copolymer, a metal ion neutralized product of each of the copolymers, or a mixture of each copolymer and the neutralized product; 5 to 80 parts by weight of a fatty acid having a molecular weight of at least 280 or derivative thereof; and 0.1 to 10 parts by weight of a basic inorganic metal compound capable of neutralizing acid groups in the two foregoing components.

We also necessarily did not invent the Shore D hardness and melt index of that resin compositions. *See*, paragraphs [0015] and [0017]. We also did not invent the zinc-ion neutralized ionomer resin described in paragraph [0052]. The disclosure of the acid group neutralization (at least 50 mole %), is also not our invention (*see*, paragraph [0022], as are also not the examples of suitable fatty acids in paragraph [0056] including stearic acid, behenic acid, arachidic acid and lignoceric acid. The basic inorganic metal compound disclosed in paragraph [0064] including calcium hydroxide is also not our invention. Our contribution to Higuchi '400 was certain aspects of the golf ball.

We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these

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statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: July, 23, 2003

Hiroshi Higuchi

Hiroshi Higuchi

Date: July, 24, 2003

Hirotaka Shimosaka

Hirotaka Shimosaka